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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/540,589	03/07/2006	Kazuhiko Honda	52433/802	4243
26646 7590 09/21/2007 KENYON & KENYON LLP ONE BROADWAY NEW YORK, NY 10004				
			EXAMINER LAVILLA, MICHAEL E	
			ART UNIT 1775	PAPER NUMBER
			NOTIFICATION DATE 09/21/2007	DELIVERY MODE ELECTRONIC

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

uspto@kenyon.com

Office Action Summary

Application No.

10/540,589

Applicant(s)

HONDA ET AL.

Examiner

Michael La Villa

Art Unit

1775

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-6 is/are pending in the application.
- 4a) Of the above claim(s) 1 is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 2-6 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. ____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|--|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. ____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date <u>20060125</u> . | 6) <input type="checkbox"/> Other: ____ |

DETAILED ACTION

Election/Restrictions

1. Restriction is required under 35 U.S.C. 121 and 372.
2. This application contains the following inventions or groups of inventions which are not so linked as to form a single general inventive concept under PCT Rule 13.1.
3. In accordance with 37 CFR 1.499, applicant is required, in reply to this action, to elect a single invention to which the claims must be restricted.
4. Group I, claim(s) 1, drawn to a steel sheet.
5. Group II, claim(s) 2-6, drawn to a method of making a steel sheet.
6. The inventions listed as Groups I and II do not relate to a single general inventive concept under PCT Rule 13.1 because, under PCT Rule 13.2, they lack the same or corresponding special technical features for the following reasons: The corresponding technical feature relates to the steel composition set forth in Claim 1. This composition is anticipated by Takada et al. JP 2001-140022. Takada et al. teaches the claimed steel composition, including the ratios of Mn/C and Si/C. See Takada et al. (Tables 2 and 3; and Claim 1). Since the corresponding technical feature is anticipated and/or rendered obvious by the prior art, there is no corresponding special technical feature among the claim groups, and so there is lack of unity among the claim groups. In this circumstance, restriction is appropriate.
7. During a telephone conversation with Mr. Kelly on 24 July 2007 a provisional election was made with traverse to prosecute the invention of Group II, claims 2-6. Affirmation of this election must be made by applicant in replying to this Office action. Claim 1 is withdrawn from further consideration by the examiner, 37 CFR 1.142(b), as being drawn to a non-elected invention.

8. Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a request under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

Claim Objections

9. Claims 2-6 are objected to under 37 CFR 1.75(c), as being of improper dependent form for failing to further limit the subject matter of a previous claim. Applicant is required to cancel the claim(s), or amend the claim(s) to place the claim(s) in proper dependent form, or rewrite the claim(s) in independent form. To the extent that Claims 2-6 could be said to depend from Claim 1, such dependence may be improper for failure to limit the subject matter of a previous claim. Claim 2 makes reference to the chemical ingredients of Claim 1, as opposed to the entirety of Claim 1. To the extent that this limited dependency is what is intended, the dependency is improper because other claimed features are being disavowed by Claim 2. In this circumstance, the subject matter of Claim 2 could be infringed without infringing Claim 1, which is not possible for a properly dependent claim. See MPEP 608.01(n).

Claim Rejections - 35 USC § 112

10. The following is a quotation of the second paragraph of 35 U.S.C. 112:
11. The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

12. Claims 2-6 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.
13. Regarding Claim 2, it is unclear what is meant by the phrase "a slab of a composition of chemical ingredients as set forth in claim 1." Since Claim 1 is no longer pending, it is unclear what the reference to Claim 1 requires. Furthermore, since Claim 1 includes various limitations in addition to chemical ingredients, it is unclear what is the status of those claim limitations with respect to Claim 2. To the extent that not all limitations are imported to Claim 2, the claim is not properly dependent. To the extent that all limitations are imported, the claim language could be read to mean otherwise. It is unclear what is meant by the phrase "in a continuous hot dip galvanizing facility." Does this limitation mean that annealing must occur in such a facility, or does it require that annealing and hot dipping occur concurrently? In Claim 2, at line 11, it is unclear whether "from" means "at" and whether "to" means "in."
14. Regarding Claims 2 and 3, it is unclear what is meant by the phrase "effective Al concentration." Is this other than concentration of aluminum in the plating bath as measured as the weight of aluminum to the total weight of bath ingredients?
15. Regarding Claim 6, it is unclear what is the relationship, if any, between these annealing, cooling, reheating and hot-dip galvanizing steps and those already set forth in Claims 2 and 3.

Allowable Subject Matter

16. While it is presently believed that the prior art does not teach or render obvious the intended scope of claimed subject matter, the scope of intended claimed subject matter, in view of the objections and rejections set forth above, is somewhat unascertainable. Hence, no definitive statement as to whether the claimed subject matter avoids the reviewed prior art can be made at this time.

CONCLUSION


17. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Michael La Villa whose telephone number is (571) 272-1539. The examiner can normally be reached on Monday through Friday.

18. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jennifer McNeil can be reached on (571) 272-1540. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Art Unit: 1775

19. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Michael La Villa
16 September 2007


MICHAEL E. LAVILLA PH.D.
PRIMARY EXAMINER